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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

In Re Application of: )

BOHN, David, D. )

Examiner: Nguyen, F.N. )

Serial No. 09/900,211 )

Group Art Unit: 2674 )

Filing Date: July 6, 2001 )

Conf. No.: 6278 )

For: METHOD AND APPARATUS FOR  
INDICATING AN OPERATING  
MODE FOR A COMPUTER  
POINTING DEVICE )

Atty. Dkt.: 10003357-1 )

REQUEST FOR RECONSIDERATION OF FINALITY OF OFFICE ACTION  
AND INTERVIEW SUMMARY UNDER 37 C.F.R. §1.133To: The Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the office action, paper number 6, dated December 16, 2003, applicant respectfully requests the office to reconsider and remove the final status of the office action in that the new grounds of rejection were not necessitated by the applicant's response to the first office action.

## ARGUMENT

MPEP Section 706.07(a) specifically provides that a second action should not be made final if it includes "a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. . ."

In the December 16, 2003, final office action, the examiner rejected claims 1-21 under 35 U.S.C. §103 as being obvious over newly cited art (i.e., prior art not previously of record).

Thus, there can be no dispute that the first prong of test in MPEP 706.07(a) is met. The second prong is also met, in that the amendments previously made to the claims contained "limitations which should reasonably have been expected to be claimed."

5 Because both prongs of the test set forth in MPEP 706.07(a) are met, it was improper for the examiner to have made final the December 16<sup>th</sup> office action.

The amendments to the claims previously made by the applicant on April 22, 2003, clarified that the "light generated

10 by the first illumination apparatus" and "the second illumination apparatus" provides "for a user a visual indication" of the first and second operating modes of the computer pointing device. These amendments involve subject matter that "should reasonably have been expected to be claimed." First, the amendments related

15 to a significant aspect of the invention, namely, the notion that the invention indicates an operating mode of a computer pointing device. Indeed, this notion is contained in the title of the invention: "Method and Apparatus for Indicating an Operating Mode for a Computer Pointing Device." Second, the preambles of

20 claims 1-17 and 20, as originally filed, included the phrase "operating mode indicator apparatus." Similarly, the preambles of method claims 18 and 19, as originally filed, referenced a "method for indicating an operating mode of a computer-pointing device." Clearly, the indication of an operating mode is subject

25 matter that would reasonably be expected to be claimed.

In addition, applicant notes that MPEP 904.02 requires that "[t]he search should cover the claimed subject matter and should also cover the disclosed features that might reasonably be expected to be claimed." Therefore, the examiner's original

30 search should have uncovered all of the relevant art the first time around, including the newly cited references in the December 16<sup>th</sup> office action. If, as here, new art is cited, and new rejections made, the applicant at least needs to be given a full and fair opportunity to respond to the new rejections. Placing

35 the applicant under "final" deprives the applicant of that

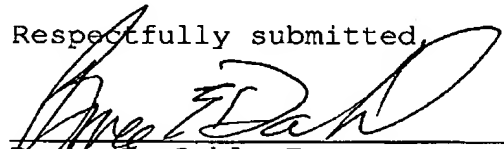
opportunity.

Accordingly, applicant respectfully requests the examiner to reconsider and remove the final status of the December 16, 2003, office action. Applicant also specifically requests that the response period be reset pursuant to MPEP 710.06.

#### INTERVIEW SUMMARY

On January 16, 2004, the undersigned counsel conducted a telephone interview with the examiner regarding this issue and specifically requested the examiner to remove the final status of the December 16, 2003, office action and to re-set the response period. While no agreement was reached, the examiner suggested that the applicant file a written request for reconsideration.

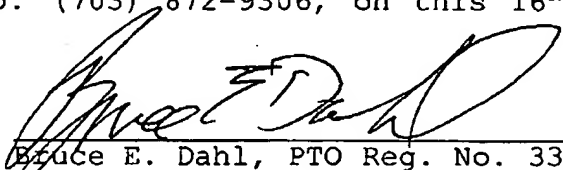
Respectfully submitted,

  
Bruce E. Dahl, Esq.  
Attorney for Applicant  
PTO Registration No. 33,670  
DAHL & OSTERLOTH, L.L.P.  
555 17<sup>th</sup> Street, Suite 3405  
Denver, CO 80202  
(303) 291-3205

Date: 1-16-04

#### CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. 1.8

I hereby certify that the attached REQUEST FOR RECONSIDERATION OF FINALITY OF OFFICE ACTION AND INTERVIEW SUMMARY is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on this 16<sup>th</sup> day of January 2004.

  
Bruce E. Dahl, PTO Reg. No. 33,670